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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,193	10/15/2001	Avi J. Ashkenazi	GNE.2630P1C6	4687

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EXAMINER

TURNER, SHARON L

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/978,193	Applicant(s) ASHKENAZI ET AL.	
	Examiner Sharon L. Turner	Art Unit 1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 58-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 58-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2-20-02, 4-28-02</u> | 6) <input checked="" type="checkbox"/> Other: <u>4-28-03</u>                            |

## DETAILED ACTION

### *Priority*

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e), 120 and 365(c) as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Applicant's have amended the first line of the specification as directed in the preliminary amendment submitted 9-3-02. The amendment identifies multiple US serial numbers, PCT international applications and provisional applications. Applicant's have also submitted a supplemental communication providing a priority map which identifies particular applications in which PRO320 (SEQ ID NO:118 and 119) is disclosed. The map notes the first disclosure within US provisional 60/078,004. These sequences are found in this priority application. However, utility is granted based upon activity in  
EXAMPLE 109: Ability of PRO Polypeptides to Inhibit Vascular Endothelial Growth Factor (VEGF) Stimulated Proliferation of Endothelial Cell Growth (Assay 9) at p. 326 of the specification. Yet, support for activity in this assay is not found in the priority applications until the filing of PCT/US99/05028, filed 3-8-99. As priority is not found until the 3-8-99 filing date, this application has been examined with the effective filing

date of 3-8-99. Priority cannot be granted where no support for the activity of the noted sequences is provided.

Should the Applicant disagree with the Examiner's factual determination above, it is incumbent upon the Applicant to provide the serial number and specific page numbers of any parent application filed prior to 3-8-99 which specifically supports the claim limitations for each and every claim limitation in all the pending claims which Applicant considers to have been in possession of and fully enabled prior to 3-8-99.

Applicant is required to clarify the priority claim in accordance with the above noted requirements including all co-pending applications and their designated relationships upon which priority is claimed. As priority lineage cannot be definitively determined the application has been examined with the effective filing date of 3-8-99.

#### **Utility**

2. Utility is established based upon EXAMPLE 109: Ability of PRO Polypeptides to Inhibit Vascular Endothelial Growth Factor (VEGF) Stimulated Proliferation of Endothelial Cell Growth (Assav 9) at p. 326 of the specification.

#### **Specification**

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

#### ***Claim Objections***

4. Claim 63 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper

dependent form, or rewrite the claim(s) in independent form. It is unclear how the term specifically binds is intended to further limit claim 58. Traversal should include an explanation of how the claim is deemed to further limit claim 58.

### **Claim Rejections - 35 USC § 112**

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 63 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 63 is directed to an antibody that "specifically binds" to the polypeptide of SEQ ID NO:231. The term "specifically binds" is indefinite to the artisan because it is unclear how "specifically" is intended modify "binds", i.e., it is unclear what type of binding is intended to be included or excluded from the claim. Clarification is required, particularly in light of claim 58 from which the claim depends.

### **Claim Rejections - 35 USC § 102**

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 58-63 are rejected under 35 U.S.C. 102(e) as being anticipated by Ford et al., US Patent No. 6,392,018 filed 2-12-1999 and issued May 21, 2002.

Ford et al., teach EGF Motif protein obtained from fetal liver-spleen cDNA library, see in particular title, abstract. The protein is distinguished by Ford as SEQ ID NO:19 bearing 100% similarity to instant SEQ ID NO:119 encoded by SEQ ID NO:118. Ford teaches antibodies including monoclonals, humanized and antibody fragments as noted in columns 43-44, in particular column 43, lines 10-18 and lines 19-25. Labeled antibodies are disclosed at column 44, lines 23-52. Specific binding is noted at column 43, lines 10-12. Heterologous and chimeric sequences including with Fc domain are noted at column 7, lines 15-30, column 9, lines 21-26, column 10, lines 30-50 and columns 13-17. Thus, the reference teachings anticipate the claimed invention.

### **Status of Claims**

9. No claims are allowed.

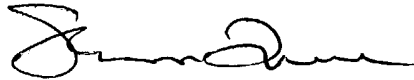
10. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 1647

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon L. Turner, Ph.D. whose telephone number is (571) 272-0894. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached at (571) 272-0887.

A handwritten signature in black ink, appearing to read 'Sharon L. Turner', with a stylized, flowing script.

Sharon L. Turner, Ph.D.  
June 23, 2004